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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,101	01/13/2004	David M. Small	P02696-2	2924
28548	7590	11/22/2005	EXAMINER	
STONEMAN LAW OFFICES, LTD 3113 NORTH 3RD STREET PHOENIX, AZ 85012			BUI, LUAN KIM	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/757,101

Applicant(s)

SMALL ET AL.

Examiner

Luan K. Bui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10 and 12-16 is/are rejected.
- 7) ☒ Claim(s) 8 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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1. Claims 17-20 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/4/2005. The traversal is on the ground that "if the search ... distinct inventions" as indicated in the response is noted. This is not found persuasive because the inventions are independent and distinct from each other and because examination of each invention will necessitate disparate searches which would clearly pose a burden as shown by the examiner in the requirement.

The requirement is still deemed proper and is therefore made **FINAL**.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 9, the phrase "said at least one cover" lacks proper antecedent basis.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Niada (5,954,256). Niada discloses a storage system related to storing at least one roll of material (B) and to dispensing material from at least one selected such at least one roll of material (A) comprising at least one container/container means (1) to contain the at least one roll of material and at least one material dispenser/dispensing means (20) to dispense material from the at least one select roll of material. The container including at least one storage holder to removably hold the at least one roll of material (B) and at least one dispensing holder adapted to hold the at least one selected roll (A) and the at least one storage holder and the dispensing holder consist essentially of one unitary piece (Figures 1-2).

As to claim 9, Niada discloses the at least one material dispenser comprises at least one slot (20) formed between the storage holder and the at least one cover (2).

6. Claims 1, 2, 7, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Cravatt (6,161,794). Cravatt discloses a storage system related to storing at least one roll of material (102) and to dispensing material from at least one selected such at least one roll of material (100) comprising at least one container/container means (10, 12) to contain the at least one roll of material and at least one material dispenser/dispensing means to dispense material from the at least one select roll of material. The container including at least one storage holder to removably hold the at least one roll of material (102) and at least one dispensing holder adapted to hold the at least one selected roll (100) and the at least one storage holder and the dispensing holder consist essentially of one unitary piece (Figures 1-2).

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As to claims 7 and 13, the area above the storage holder to the roll (102) is considered equivalent to at least one accessory holder as claimed to hold at least one roll of material (104). The accessory holder of Cravatt is inherently capable of holding at least one roll of ribbon.

As to claim 9, Niada discloses the at least one material dispenser comprises at least one slot (20) formed between the storage holder and the at least one cover (2).

7. Claims 1, 2, 4 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris (4,124,259). Harris discloses a storage system related to storing at least one roll of material (36) and to dispensing material from at least one selected such at least one roll of material (10) comprising at least one container/container means (12) to contain the at least one roll of material and at least one material dispenser/dispersing means (10) to dispense material from the at least one select roll of material. The container including at least one storage holder to removably hold the at least one roll of material (36) and at least one dispensing holder adapted to hold the at least one selected roll (10) and the at least one storage holder and the dispensing holder consist essentially of one unitary piece (Figures 1-2).

As to claim 4, Harris further discloses at least one cover (28) and the cover of Harris is inherently capable to allow stacking at least one storage system on top of the at least one cover.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-6 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niada (5,954,256) or Cravatt (6,161,794) or Harris (4,124,259) in view of Barough'697 (3,930,697) or Dunn et al. (5,207,367; hereinafter Dunn'367). Either Niada or Cravatt or Harris discloses the storage system as above having all the limitations of the claims except for the storage holder and the dispensing holder consist essentially of one unitary piece of molded plastic. Barough'697 shows a storage system (10) formed from of plastic material. Dunn'367 teaches a storage system (10) formed from of plastic material. It would have been obvious to one having ordinary skill in the art in view of Barough'697 or Dunn'367 to modify the storage holder and the dispensing holder of Niada or Cravatt or Harris so the storage holder and the dispensing holder consist essentially of one unitary piece of molded plastic since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As to claim 4, Dunn'367 teaches the at least one container comprises at least one cover (22) adapted to allow stacking at least one storage system on top of the at least one cover.

As to claim 5, Cravatt discloses at least one separator (34, Figure 5) or Harris discloses a separator (Figure 2).

As to claims 6, 12 and 13, Dunn'367 teaches cutting means (26) is considered equivalent to at least one cutting guide as claimed to guide cutting dispensed material and the cutting means connected to the storage system/unitary piece.

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As to claim 14, the storage system of either Niada or Cravatt or Harris or Dunn'367 is capable of holding wrapping paper.

*Allowable Subject Matter*

10. Claims 8 and 11 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (571) 272-4552. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ms. Errica Miller at (571) 272-4370. **Facsimile correspondence for this application should be sent to (571) 273-8300 for Formal papers and After Final communications.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lkb  
November 18, 2005



Luan K. Bui  
Primary Examiner